

**REMARKS**

The present amendments and remarks are in response to the Office Action mailed on September 30, 2003. Claims 1-22 have been allowed. Claims 23-26, 29-31, and 33-39 have been rejected. Claims 27-28, and 32 have been objected to. Accordingly, claims 1-39 are currently pending.

The Applicant appreciates the allowance of claims 1-22, but respectfully requests reconsideration of the rejected claims in view of the following responsive remarks. For the Examiner's convenience and reference, the Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

In the Office Action, the following actions were detailed:

- (1) The Examiner indicated that the first sentence is devoid of a specific reference to the prior nonprovisional application from which this application is a continuation-in-part;
- (2) claims 23 and 26 were rejected under the judicially created doctrine of obviousness-type double patenting over claim 6 of U.S. Pat. No. 6,417,248 (Gore);
- (3) claims 30 and 33-39 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite;
- (4) claims 23-26 and 29-31 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kurabayashi (U.S. 2002/0077386) in view of Gundlach (U.S. 6,276,792); and
- (5) claims 27-28 and 31 were objected to as being dependent upon a rejected base claim.

### **Priority Claim**

The Applicant appreciates the Examiner's notice of the priority requirement, and informing the Applicant of the requisite reference. Accordingly, the Applicant has amended the specification so that the appropriate priority information has been inserted before the FIELD OF THE INVENTION section and after the title. It is believed that no new matter is added by the insertion of this section into the specification because the information is already on the front page of the published patent application, and was included with the original transmittal filed with the application.

### **Double Patenting**

The Examiner has rejected claims 23 and 26 under the judicially created doctrine of obviousness-type double patenting over claim 6 of U.S. Patent No. 6,417,248 (Gore). In accordance with this rejection, the Applicant submits herewith a terminal disclaimer in compliance with 37 CFR 1.321(c). Reconsideration of this rejection is respectfully requested.

### **Rejections Under 35 U.S.C. 112**

The Examiner has rejected claims 30 and 33-39 under 35 U.S.C. 112, second paragraph, as being indefinite. Specifically, the Examiner stated that claim 30 recites the limitation "the liquid vehicle" without sufficient antecedent basis. Also, the Examiner stated that the phraseology of claim 33 is confusing and not clear. As such, the Applicant has amended the claims. Specifically, claim 30 has been amended to remove the antecedent basis issue associated with this claim. Additionally, claim 33

has been rephrased in accordance with the Examiner's recommendation. The Applicant believes these amendments do not add new matter, and that such claim amendments are not narrowing amendments. Reconsideration is respectfully requested.

**Rejections Under 35 U.S.C. 103(a)**

Before discussing the obviousness rejections herein, it is thought proper to briefly state what is required to sustain such a rejection. The issue under § 103 is whether the PTO has stated a case of *prima facie* obviousness. According to the MPEP § 2142, the Examiner has the burden and must establish a case of *prima facie* obviousness by showing some motivation in a prior art reference to modify that reference, or combine that reference with multiple references, to teach all the claim limitations in the instant application. The Applicant respectfully asserts the Examiner has not satisfied the requirement for establishing a case of *prima facie* obviousness in these rejections.

The Examiner has rejected claims 23-26 and 29-31 under 35 U.S.C. 103(a) as being unpatentable over Kurabayashi (U.S. 2002/0077386) in view of Gundlach (U.S. 6,276,792). The Applicant asserts that neither of the prior art references provide a basis for the motivation to combine these references, and that the combination can only be a result of hindsight analysis.

Kurabayashi teaches the prevention of ink bleed upon printing on recording paper by mixing a liquid composition and ink on a substrate (par. 0037). In a first step, the ink and liquid composition react when the low-molecular weight cationic substance or cationic oligomer contained in the liquid composition associates with the water-soluble dye having an anionic group (par. 0037), where the cationic oligomer

can contain 2-oxazoline monomer units (par. 0060). In a second step of the reaction, the aggregates formed by the association of the dye and the low-molecular weight cationic substance or cationic oligomer are adsorbed on the nonionic or cationic polymeric substances (par. 0038). According to Kurabayashi, the liquid composition is required to contain the cationic substance or oligomer and the nonionic or cationic polymer (par. 0060 and par. 0069). The improvement is obtained when the aggregates increase in size, and it becomes difficult for them to enter into the interfiber spaces of the recording paper, which results in improved coloring ability and reduced bleeding (par. 0038). However, Kurabayashi is completely devoid of teaching that the mixture can be fused to provide improvements. The teachings of Kurabayashi indicate that it is the increased size of the aggregates formed by specific chemical associations of three components that provides the improvement. The three requisite components required for the aggregate formation are the anionic dye, the cationic substance or oligomer, and the nonionic or cationic polymer.

Gundlach teaches charging the non-image side of a substrate, depositing charged colorless toner onto the image side of the substrate, depositing the ink onto the colorless toner, and fusing the toner and ink to the substrate (col. 3, ln. 1-44). Gundlach teaches that the colorless toner contains various polymers and substances (col. 5, ln. 22 to col. 6, ln. 18), none of which comprise an oxazoline or polyoxazoline. Additionally, Gundlach requires fusing by heat, light, pressure, and combinations thereof (col. 4, ln. 36-40). Gundlach does not teach aggregate formation by chemical association.

The Applicant objects to the Examiner's combination of Kurabayashi and Gundlach because neither of the references provides motivation for combination with the other. The Courts have stated that the prior art must teach or suggest the making

of a combination of prior art references in order to render a claimed invention obvious. *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In other words, one must be motivated by the prior art references themselves to make the proposed combinations necessary to arrive at the instant invention. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). Absent such motivation, a rejection based on a combination of such references is unsupported, and any rejection based on such a combination must be withdrawn.

The Applicant respectfully asserts these prior art references do not provide the requisite motivation for combination. Kurabayashi teaches a three-component system, where the components form aggregates by chemical associations to provide the improvement. Kurabayashi is completely devoid of any indication that these components can be fused, and does not teach any means to accomplish fusing of the components. On the other hand, Gundlach teaches fusing a toner with ink on a substrate, where the toner lacks the materials specifically required by Kurabayashi. These prior art references do not provide any motivation for the combination. In fact, these references are at odds as the liquid compositions are dissimilar, and the means for the image improvements are separate and distinct, i.e. chemical aggregation compared to heat fusing. For these reasons, the Applicant respectfully requests withdrawal of this rejection.

In addition to the fact that there is no motivation to modify or combine the references cited, the Applicant asserts that the Examiner has used the Applicant's own specification as a roadmap for the proposed combination. The Courts have stated that the Applicant's specification cannot be the basis for motivation, i.e., no hindsight reconstruction. *Yamanouchi Pharmaceutical Co., Ltd. v. Danbury Pharmacal, Inc.*, 231 F.3d 1339, 56 U.S.P.Q.2d 1641 (Fed. Cir.), reh'g denied, 2000 U.S. App. LEXIS

34047 (2000). Accordingly, the use of the Applicant's specification to provide the teaching for using a polyoxazoline and a method/system for fusing is not permissible, and any rejection based on hindsight must be withdrawn.

To illustrate that hindsight analysis has been used to reconstruct the presently claimed invention, the Applicant asserts that one of ordinary skill in the art would be required to combine two references with inapposite teachings in order to arrive at the presently claimed invention. More specifically, both Kurabayashi and Gundlach utilize distinct and separate compositions as well as distinct and separate means for achieving the improvement. No motivation for combination arises from either of these references. As such, the Examiner is respectfully requested to reconsider and withdraw these rejections.

#### **Claim Objections**

Claims 27-28 and 31 were objected to as being dependent upon a rejected base claim. The Examiner has indicated that these claims would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. However, the Applicant believes the amendments and remarks contained herein are adequate to distinguish the claimed invention from the prior art. Accordingly, the Applicant does not believe any amendment is needed to overcome these objections.

In view of the foregoing, the Applicant believes that all pending claims present allowable subject matter and the withdrawal of all rejections is respectfully requested. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be removed during a

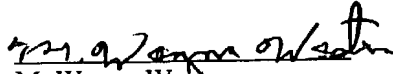
telephone interview, the Examiner is invited to telephone Brad Haymond at (541)

715-0159, so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any  
overpayment to Deposit Account No. 08-2025.

Dated this 30<sup>th</sup> day of Dec., 2003.

Respectfully submitted,

  
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